

Congressman Andy Biggs (AZ-05)
Question for the Record to USPTO Director Iancu

1. In recent weeks, the Patent Trial and Appeal Board (“PTAB”) has designated two decisions as precedential—including one in which you sat on the panel—enforcing the agency’s discretion under 35 U.S.C. 325(d) to reject repetitive claims filed by the same or a different challenger against the same patent.¹

Despite these precedential decisions, there have been reports that the Central Reexamination Unit (under the authority of the Commissioner for Patents, not the PTAB) does not feel bound by the PTAB’s precedential decisions and is therefore allowing multiple reexaminations to be ordered against the same patent.²

- As a general policy matter, do you think it is appropriate to grant a request for ex parte reexamination, if the request asserts the same or substantially the same prior art or argument that was previously presented by the same person in an inter partes review petition which the PTAB declined to institute against the same patent claims?
 - As the head of the agency, what steps have you taken—or plan to take—to ensure that the PTAB’s precedential decisions involving 35 U.S.C. 325(d) are applied consistently by different components of the agency, including by the Central Reexamination Unit and the Office of Patent Legal Administration, in cases deciding whether to grant or reject a request for ex parte reexamination?
 - Given that the statutory authority under 35 U.S.C. 325(d) is vested in you as the “Director,” do you have any plans to personally sign a decision rejecting a reexamination request, analogous to the various PTAB panels on which you have personally sat?
2. Several patents have been determined to be valid in a district court and invalid in the PTAB. What is the legal condition of said patent?
 3. How many patents have completed in one or more AIA trials?
 4. How many patents have been partially invalidated by AIA trials?
 5. How many patents have been fully invalidated by AIA trials?

¹ Valve Corp. v. Electronic Scripting Products Inc., IPR2019-00062, -00063, -00084 (precedential May 7, 2019); NHK Spring Co. Ltd. v. Intri-Plex Technologies Inc., IPR2018-00752 (precedential May 7, 2019).

² Patents Post Grant, AIA Statutes Can Impact Patent Reexamination Orders (June 26, 2018) (“[T]here has been little guidance from the agency on the use of 325(d) analysis in patent reexamination...”); Ex Parte Reexam No. 90/013,808 (June 15, 2018) (ordering reexamination and declining to exercise 325(d) authority); Ex Parte Reexam No. 90/014,217 (April 11, 2019) (ordering reexamination and declining to exercise 325(d) authority).